

## **REMARKS/ARGUMENTS**

### *Claims*

The Examiner rejected claims 8-14 and 21-29. By this amendment, claim 8 has been amended. Therefore claims 8-14 and 21-29 remain pending in the application.

### *Claim Rejections – 35 USC §112*

Claims 8-14 and 21-29 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Examiner asserted that the last limitation of claim 8, which is “wherein the visible content and the invisible coded data are printed substantially simultaneously,” could not be found in any part of the specification. The rejection is respectfully traversed.

Independent method claim 8 has been amended to include the limitation “wherein the visible content and the invisible coded data are printed by the same printer substantially simultaneously.” In the present office action the Examiner respectfully acknowledged “that the printer simultaneously prints multiple colors and infrared inks....” The Examiner continued by stating “...however, this does not suggest that invisible and visible codes are printed simultaneously per se.” Thus the examiner has acknowledged that the added limitation of the same printer printing both multiple colors and infrared inks is described by the specification. The necessary support for printing invisible codes and visible content substantially simultaneously is described below.

Co-pending U.S. Application No. 09/575,146, filed May 23, 2000, now patent 6,785,016, issued August 31, 2004, and incorporated by reference into the present application (see page 2 of the specification, line 27), states in claim 53: “A printer according to claim 50, wherein the printer is configured to print the second coded data and additional information substantially simultaneously onto the second surface.” The second surface is defined in claim 1 as a surface onto which is printed a second interface. Patent No. 6,785,016 further includes the identical paragraph (at col. 6, lines 18-33) describing graphic data printed using visible ink, and coded data printed as a collection of tags using invisible ink, that is included in the present specification beginning at page 8, line 5, which is amended by the present amendment. Therefore the present specification has been amended to include the statement that “The graphic data 2 and the coded data 3 are printed substantially simultaneously.” See MPEP 201.06(c)IV: “The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuation or divisional application to include any subject matter in such prior application(s), without the need for a petition provided the continuation or divisional application is entitled to a filing date notwithstanding the incorporation by reference.”

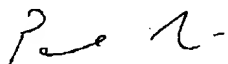
The Applicants respectfully assert that the terms “graphic data”, “visible content” and “additional information” as used in the present specification and in the specification of patent 6,785,016, all refer to the same thing: that is, visible content (e.g., text, graphics, etc.) printed on a surface, and which is distinguished from the invisible coded data of the present invention. Further, the Applicants assert that an *in haec verba* recitation of the claim language in the specification is not required to satisfy the written description requirement. See, e.g., MPEP 1302.01: “It should be noted, however, that exact terms need not be used in *haec verba* to satisfy the written description requirement of the first paragraph of 35 U.S.C. 112. *Eiselstein v. Frank*, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995); *In*

*re Wertheim, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976). See also 37 CFR 1.121(e) which merely requires substantial correspondence between the language of the claims and the language of the specification.*" In the present application, the Applicants assert that there is now substantial correspondence between the language of the claims and the language of the specification.

Accordingly, it is submitted that the application is now in condition for allowance. Reconsideration and allowance of the application is courteously solicited.

Very respectfully,

Applicant:



---

PAUL LAPSTUN

Applicant:



---

KIA SILVERBROOK

C/o: Silverbrook Research Pty Ltd  
393 Darling Street  
Balmain NSW 2041, Australia

Email: [kia.silverbrook@silverbrookresearch.com](mailto:kia.silverbrook@silverbrookresearch.com)

Telephone: +612 9818 6633

Facsimile: +61 2 9555 7762